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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/417,266 10/12/99 MAROPIS

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EXAMINER

FOSTER, R	
ART UNIT	PAPER NUMBER

2645
DATE MAILED:

09/10/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/417,266

Applicant(s)

MAROPIS ET AL.

Examiner

Roland G. Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

The applicant's remarks on pages 2 and 3 of amendment, filed on July 3, 2001 as Paper No. 8, with respect to the 35 USC § 112, Second Paragraph rejection were persuasive in that the applicant stated that "claim 15 defines a version of how to establish a subscriber account and does not recite two separate accounts". Therefore, the subject 35 USC § 112, Second Paragraph rejection for claim 15 is withdrawn

On page 6, last paragraph and page 7, first paragraph of amendment, the applicant remarks with respect to Cohen et al. (U.S. Patent No. 5,946,380) and to claim 1:

"Unlike Cohen, where a call is monitored for its duration by a call processor so that time and value are decremented, claim 1 recites the operation of an application server 22 in a prepaid local telephone system that a) tracks general service activation periods for prepaid local telephone service subscribers and b) does not interact with subscribers on a call by call bases to monitor the duration of individual calls."

Although the applicant's remarks have been duly considered, they are not deemed fully persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., application server 22 in a prepaid local telephone system that tracks general service activation periods for prepaid local telephone service subscribers and does not interact with subscribers on a call by call basis to monitor the duration of individual calls) are not recited in the rejected claim 1. Although the claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 7, paragraph 2 of the amendment, the applicant remarks, "Cohen lacks any teaching of a value identification number associated with a prepaid local telephone service program"

Although the applicant's remarks have been duly considered, they are not deemed fully persuasive. Cohen states at col. 4, lines 43-45 that a "dollar value for the customer placing the call" is determined for the subscriber's account. A dollar value is a "value" that "identifies" and "number" associated with the prepaid service. Since the dollar value (value identification number) exists in the account before the call, the account is prepaid. See also the abstract.

Page 7 also contains other arguments directed to features not recited in rejected claim 1 as discussed above.

On page 9, paragraphs 1 and 2 of the amendment, the applicant remarks that the newly introduced limitation, "means for monitoring a subscriber service period without monitoring a duration of individual telephone calls" distinguishes over Cohen.

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Although the applicant's remarks have been duly considered, they are not deemed fully persuasive. Cohen discloses a means for monitoring a subscriber service period without monitoring a duration of individual telephone calls. Specifically, col. 3, lines 51-55 of Cohen discloses a means for monitoring only call attempts during the period where the subscriber's balance is depleted. During this period, the pre-paid service does not monitor the duration of the call. The call duration may or may not be monitored by normal billing means however normal billing means are separate from the pre-paid service as disclosed.

On page 8, last paragraph of the amendment, the applicant remarks:

"The Cohen reference discloses making 'a regular toll call' (Col. 4, lines 27-31). The Cohen reference lacks any teaching of a prepaid local telephone service or establishing a subscriber account on a prepaid local telephone service database."

Although the applicant's remarks have been duly considered, they are not deemed fully persuasive. The claims recite a prepaid local telephone service, not a prepaid service that is only available when making non-toll (long distance) calls. For example, see Fig. 5 and col. 5, lines 28-35 where the Control Processor 102 that contains the various databases (Fig. 2) is connected to the "Local" Exchange Carrier (LEC) 520. Therefore, the prepaid telephone service can be considered as locally available in the area or a local service (at the LEC).

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On page 9, last paragraph of the amendment, the applicant remarks:

"Cohen... fails to teach or suggest a suspend message specifically comprising an instruction to suspend local telephone service for a subscriber".

Although the applicant's remarks have been duly considered, they are not deemed fully persuasive. Cohen teaches that the service can be terminated when the balance is empty and restarted if the balance is "replenished" (col. 3, lines 43-47). Therefore, the service can be said to be temporarily "suspended" when the balance is empty. The service does not randomly or spontaneously suspend when the balance is empty or restart when the balance is replenished, it must receive instructions to suspend when the balance is empty and to restart when the balance is replenished. The instructions themselves form a message. Therefore, Cohen discloses a suspend message comprising an instruction to suspend local telephone service for a subscriber.

For the above reasons, the following rejections are repeated except where any new rejections are set forth as necessitated by amendment.

Claims 1 and 3-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohen et al. (U.S. Patent No. 5,946,380) [Hereinafter Cohen].

With respect to claim 1, the following limitations read upon Cohen.

“...prepaid local telephone services...” reads on the abstract. Note that the limitation recites a prepaid local telephone service, not a prepaid service that is only available when making non-toll (long distance) calls. For example, see Fig. 5 and col. 5, lines 28-35 where the Control Processor 102 that contains the various databases (Fig. 2) is connected to the “Local” Exchange Carrier (LEC) 520. Therefore, the prepaid telephone service can be considered as locally available in the area or a local service (at the LEC).

“receiving a telephone call from the subscriber” and “identifying a subscriber account in a prepaid local telephone call database for the subscriber based on the telephone number of the subscriber” reads on col. 4, lines 33-37.

“receiving a value identification code associated with a prepaid local telephone service program” and “determining a period of service for the identified subscriber account” reads on col. 4, lines 42-55 where a dollar amount (value identification code) and a time (period of service) are determined. In other words, a dollar value is a “value” that “identifies” and “number” associated with the prepaid service. Since the dollar value (value identification number) exists in the account before the call, the account is prepaid. See also the abstract.

“monitoring the period of service at the prepaid local telephone call database” reads on col. 4, lines 55-59.

“sending termination date information to the subscriber prior to an expiration of the period of service” is a broad limitation and reads on col. 3, lines 40-60 where the system informs the subscriber that the subscriber’s budget has been exceeded “for the month” which implies the “current” month and therefore a series of unique dates that inherently comprise the “current” month. A series of dates can be said to be “date information”. Since the “date information” pertains to preventing all further calls from being charged to the prepaid service (col. 3, lines 58-60), the date information can be said to be “termination” date information with regard to the prepaid service. The termination date information is sent to the subscriber “prior” to terminating the service (expiration of the period of service).

Claim 8 differs substantively from claim 1 in that claim 8 recites a telephone network that performs the functions equivalent to the methods performed in claim 1. Therefore, see the claim 1 rejection for additional details. Claim 8 also contains the following limitations which read on Cohen.

“a prepaid local telephone call service center in communication with at least one local exchange carrier...” reads on Fig. 1, Call Expenditure Control Server (125) and LEC (52) which would be part of the local exchange carrier (local telephone company).

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"an application server having a processor and a subscriber database" reads on Fig. 1, Call Expenditure Control Server (125) and Control Processor (102) and col. 4, lines 35-45.

"means for monitoring a subscriber service period without monitoring a duration of individual telephone calls" reads on col. 3, lines 51-55 where Cohen discloses a means for monitoring only call attempts during the period where the subscriber's balance is depleted. During this period, the pre-paid service does not monitor the duration of the call.

With respect to claim 14, the following limitations read upon Cohen.

"establishing a subscriber account on a prepaid local telephone service database, the subscriber account comprising subscriber identification information and a period of service" reads on col. 3, lines 13-21.

"monitoring the period of service for the subscriber account at the prepaid local telephone service database independently of a duration of a subscriber telephone call" reads on col. 4, lines 55-59 and col. 3, lines 51-55 where Cohen discloses a means for monitoring only call attempts during the period where the subscriber's balance is depleted. During this period, the pre-paid service does not monitor the duration of the call.

“sending service termination information to the subscriber prior to an expiration of the period of service” reads on col. 4, lines 64-67.

Claim 16 substantively differs from claim 14 in the claim 16 recites that “a reminder message” is sent to the subscriber prior to expiration which reads on col. 4, lines 63-67 (or col. 3, lines 25-26). Therefore, see the claim 14 rejection for additional details. Claim 16 also recites sending a “suspend message” comprising “an instruction to suspend local telephone service for the subscriber” which reads col. 3, lines 43-47 where Cohen teaches that the service can be terminated when the balance is empty and restarted if the balance is “replenished” (col. 3, lines 43-47). Therefore, the service can be said to be temporarily “suspended” when the balance is empty. The service does not randomly or spontaneously suspend when the balance is empty and restart when the balance is replenished, it must receive instructions to suspend when the balance is empty and to restart when the balance is replenished. The instructions themselves form a message. Therefore, Cohen discloses a suspend message comprising an instruction to suspend local telephone service for a subscriber. If the caller is no longer using the prepaid calling service because the account is fully withdrawn, the account can be said to be “inactive” (no funds withdrawn for prepaid service for long distance calls).

With respect to claim 3, see col. 4, lines 63-67.

With respect to claims 4 and 10, the claim is worded broadly and reads on Fig. 5 where the service is implemented in a Local Exchange Carrier (local telephone company). The message comprising the "hold order" reads on a message inherently required by the LEC to prevent the subscriber from using the service after expiration (col. 3, lines 58-60). Since the service is restarted if the subscriber makes other arrangements for payment (col. 8, lines 35-40), the message can additionally be considered as placing the service on "hold" pending other payment arrangements. The message comprising the "hold order" also reads on the actual message sent to the subscriber inviting the subscriber to make other arrangements for the call (col. 8, lines 35-40).

With respect to claims 5 and 11, see col. 3, line 27.

With respect to claims 6 and 12, see col. 3, lines 29-31. Charging to the regular account during the grace period inherently requires "monitoring".

With respect to claims 7 and 13, see col. 3, lines 31-38 where the grace period ends after the call is completed. On subsequent calls, calls to the prepaid service are blocked (cancel order) until the caller modifies the service. See Fig. 5 for implementation of the service at the Local Exchange Carrier (local telephone company) which receives a message to block the call.

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With respect to claim 9, see col. 3, lines 29-32. See also Fig. 5 for implementation of the service at the Local Exchange Carrier (local telephone company).

With respect to claim 10, see the claim 16 rejection for further details.

With respect to claim 15, as it can best be understood, see the claim 1 rejection for further details.

With respect to claim 17, the "grace period" comprises the time required to start 37 (from when the suspend message is sent) and complete the announcement of col. 3, lines 34-40. The announcement is of a predetermined length. Therefore the grace period can be said to comprise a "predetermined length from when the suspend message is sent. Since the caller is blocked from the prepaid service upon subsequent calls after the suspend message, the caller can be said to be "disconnected" from the service after expiration of the grace period if the subscriber has not modified (renewed) the account subscriber. See also Fig. 5 for implementation of the service at the Local Exchange Carrier (local telephone company).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen as applied to claim 1 above, and further in view of Taskett.

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Although Cohen teaches the use of a voice response unit (col. 3, line 10), Cohen fails to disclose that voice recognition is used.

However, Taskett discloses of a similar telephone service system with expiration monitoring that uses voice recognition (col. 8, lines 10-15).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the voice recognition as taught by Taskett to the voice response unit disclosed by Taskett.

The suggestion/motivation for doing so would have been to increase user-friendliness and flexibility by allowing the subscriber to enter information by speaking in addition to entering information on a telephone keypad. Additionally, the concept of a voice response unit that allows users to either speak or use a telephone keypad, such as "Press or speak 1 for savings" is notoriously well-known in the art.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen as applied to claim 16 above.

With respect to claim 18, Cohen fails to disclose, but "Official Notice" is taken that both the concept and advantages of providing free access to a prepaid service

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when the caller is attempting to make an emergency call are both well-known and expected in the art.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add free access to a prepaid service when the caller is attempting to make an emergency call to Cohen.

The suggestion/motivation for doing so would have been to increase safety by allowing those in emergency situations to make calls to emergency telephone numbers such as 911 as is notoriously well-known in the art.

With respect to claim 19, see the claim 17 rejection for further details.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.

r.g.f. R.C.F.
August 31, 2001

FAN TSANG
SUPERVISORY PATENT EXAMINER
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